

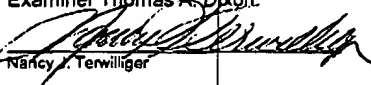
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4-17-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Patent Application of Veeneman et al.) Group Art Unit: 3629
Serial No.: 09/610,158) Examiner: Thomas A. Dixon
Filed: June 30, 2000) Docket No.: 13212.137 REUS
(Former 9203/046 RE)
For: MULTI-MERCHANT GIFT REGISTRY)

Certificate of Transmission Under 37 CFR 1.8

I hereby certify that this correspondence, along with all papers referred to as being transmitted, are being facsimile transmitted to the Patent and Trademark Office. Fax No. (703) 305-7687, attention Examiner Thomas A. Dixon.


Nancy J. Terwilliger

Date

Apr 15, 2003

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Box After-Final
Attention: Examiner Dixon
Assistant Commissioner for Patents
Washington, DC 20231

APR 16 2003

GROUP 3600

REQUEST FOR RECONSIDERATION

OFFICIAL

Dear Sir:

In response to the FINAL Office Action dated 15 January 2003 on the above referenced patent application, please consider the following remarks in support of patentability.

REMARKS

In an Office Action dated 15 January 2003, the Examiner objected to Figure 7. The Examiner further rejected claims 1-29 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner also noted that claims 1-29 are allowable over the prior art.

The Examiner objected to a misspelling in Figure 7 and Applicant has submitted herewith an amended Figure 7.

The Examiner rejected claims 1-29 under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. The Examiner noted with respect

thereto:

A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for patent cannot be recaptured by the filing of the present reissue application.

Applicant's broadening of the claims has been considered in light of the prosecution of the parent case and it seems to be improper recapture.

Applicant's arguments of 12 September 1997, repeated in the Preliminary Amendment, argue that the registry serves a plurality of stores in a shopping area, not stores which are in spatially distant areas.

Applicant's amendment of 30 June 2000 removes the proximity limitation from both the stores and the registry, which is seen as improper recapture. Further, the text, which had been the first limitation of the original claim only occurs in the preamble, and like the other text of the preamble, will not be given weight.

Applicant's amendment of 19 June 2002 has been reconsidered and is seen to fail to remedy the improper recapture. Specifically, the amendment "that are located in an area" describing the merchants only occurs in the preamble, and like the other text of the preamble will not be given weight. Further, the phrase "located in an area" is seen to be broader than original claim's "merchants in a shopping area" and is seen to be improper recapture.

Applicant appreciates the Examiner's thorough review of the reissue application and the prosecution history of the original application for patent.

Applicant in the Preliminary Amendment dated 30 June 2000 deleted the reference to the "kiosk" from the claims, since this structure was an unnecessary and erroneous addition to the original patent. The term "kiosk" was inserted as follows in claim 1: "a gift registry kiosk disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry." Thus, the deletion of the kiosk is agreed to not be improper recapture and entails removal of the entire reference to the kiosk, including the phrase "disposed proximate the stores of a plurality of merchants in a shopping area, each of said merchants participating in the gift registry" which phrase modifies the term "kiosk"

since this phrase is descriptive of the kiosk.

Applicant also notes that the original claim 13 does not recite a proximity limitation, except in the preamble:

13. A method of operating a gift registry system capable of registering items selected by a registrant from a plurality of participating merchants in a shopping area as possible gifts for the registrant for subsequent communication to a prospective purchaser for possible purchase as gifts for the registrant, the system having a computer system, a portable input and storage device, a transfer device and a prospective purchaser interface device, the method comprising the steps of:

receiving identifying information about a registrant at the computer system;

using the portable input and storage device to select desired gifts from a plurality of participating merchants;

using the portable input and storage device to enter a unique identifier for each participating merchant, such that each gift chosen by the registrant will be identified as being from a certain merchant;

transferring the information received and stored by the portable input and storage device into the computer system via the transfer device; and interfacing with a prospective purchaser such that the prospective purchaser can view a list of the gifts desired by the registrant and the particular merchants the gifts are from.

The absence of any structural limitation that is directed to proximity in claim 13 supports Applicant's claim revisions and new claims that only note proximity in the preamble as was done in the original claim 13. In addition, the proximity recitation "that are located in an area" describing the merchants only occurs in the preamble, and like the other text of the preamble will not be given weight. Therefore, the precise wording of the proximity phrase is not given any weight and it is not believed to be improper recapture since the claim amendments only reflect the claim breadth of the original claim 13 from the issued patent. Applicant therefore believes that claims 1-29 are allowable under 35 U.S.C. 251.

Applicant therefore respectfully requests that the Examiner reconsider the present rejection of Applicant's claims and that a Notice of Allowance be issued in a timely manner. If the Examiner believes that any further issues need to be addressed, or has proposed clarifications to the claims, the undersigned is available at the convenience of the Examiner for a telephone interview to address these

Issues.

It is believed that no fees are due at this time; however, Applicants authorize the Commissioner to charge any additionally required fees to deposit account #50-1848.

Respectfully submitted,

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